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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1797

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 111 and 117 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what structure element of the apparatus will permit glucose self monitoring. Clarification could be achieved if Application were to claim a reagent for detecting glucose.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 105-109,112-115, are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (USP 4,476,870).

Peterson teaches a fiber optic probe for the measurement of physiological properties. The probe comprises two optical fibers(12,14) where each fiber has a first and second end where the first end receives light and the second end is in contact with a suitable support and indicator dye. Column 6 lines 32-38 teach the support could be the hydrophilic polymer "Amberlite XAD4" and has been read on the claimed "reagent pad." Figure 4 illustrates the polymer support has a greater diameter than the two optical fibers(12,14).

Peterson differs from the instant claims in that the porous polymer has a diameter greater than the optical fibers.

The court decided In re Boesch (205 USPQ 215) that optimization of a result variable is ordinarily within the skill of the art. A result effective variable is one that has well known and predictable results. The diameter of a reagent pad is a result effective variable with the well known and expected results of providing a greater or smaller surface area for the reactions to occur. One having ordinary skill in the art would have expected similar results of analyte detection from the pad having the same diameter as the optical fiber as compared to the pad having a diameter greater than the fibers. It would have been desirable to make the reagent pad smaller to reduce the cost of manufacturing and make it the same diameter of the optical fibers to maximize the light throughput and minimize the cost of materials/reagents.

It would have been within the skill of the art to modify Peterson et al. and make the absorbent the same diameter of the optical fiber to maximize light throughput and minimize the cost of materials/reagents.

The limitations directed to measurements “in vitro” has been interpreted as a method of intended use and are no patentable moment with respect to the pending apparatus claims.

Allowable Subject Matter

Claims 111 and 116 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art Peterson et al. teach a reagents for the measurements of oxygen and does not teach the claimed oxidase/peroxidase enzymes.

Election/Restrictions

Applicant's election with traverse of group I, claims 105-117 in the reply filed on 8/2/08 is acknowledged. The traversal is on the ground(s) that there would be no additional burden of search. This is not found persuasive because the criteria for making a restriction requirement is if the inventions are independent and distinct. The Office maintains the two inventions are independent and distinct for the reasons of record and the restriction requirement is proper.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

Applicant's arguments with respect to claims 105-117 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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